

REMARKS

Applicant has carefully considered the December 20, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-12 are pending in this application. In response to the Office Action dated December 20, 2005, claims 1 and 11 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-7, 9, 11 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated over Lin et al. (U.S. Pat. No. 6,438,888, hereinafter “Lin”). Applicant respectfully traverses.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221

USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed inventions and the device disclosed by Lin that would preclude the factual determination that Lin identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Independent claims 1 and 11 have been amended to clarify that the housing of the light assembly includes a pair of lateral members movably mounted to the housing and are movable between a retracted position and an extended position relative to the housing.

In contrast, Lin discloses pistol accessory 80 that is held within a hole or chamber provided by fixing sheath 40. The fixing sheath 40 is fixed under the elastic clipping seat 30. See col. 3, lines 15-18. As clearly evident from Fig. 3, Lin fails to disclose any lateral members on the housing of the pistol accessory 80, much less a pair of lateral members movably mounted to the housing of the pistol assembly. Neither the fixing sheath 40 or the elastic clipping seat 30 are mounted to the housing of the pistol accessory 80. Accordingly, it should be evident that Lin fails to identically disclose every feature of claims 1 and 11 as amended. As such, the rejection is not legally viable and should be withdrawn for at least this reason.

Moreover, the present claimed subject matter relates to a light assembly with a fully integrated and retractable mounting clamp. In contrast, Lin discloses a fixing rack which is external to pistol accessory 80 (flashlight) and must be fastened to a flashlight through fasteners or a clamp. Lin's fixing rack is neither integrated, nor retractable.

The present claimed subject matter includes a pair of lateral members that extend outwardly out of the body of the light assembly and retract into the body of the light assembly. Lin's device is not susceptible of being in an extended or retracted position, rather its configuration remains constant. The only moving parts are the pressing plates (jaws) that can be

opened or closed, by exerting pressure on the releasing plates. This movement is one which entails distortion of an elastic material, which returns to its basic shape, once pressure is released. Lin relies solely upon lateral pressure exerted by an elastic member to secure the rack to the weapon 50. As described in the present specification, elasticity is not relied upon to perform any function -- the fixing members of the present invention are rigid, not elastic.

Dependent claims 2-6, 9 and 12 are free from the applied art in view of their dependency from independent claims 1 and 11. The patentability of several of the dependent claims is separately argued.

With respect to claim 2, channel 329 of Lin is located on the outer face of the press plate that forms part of the elastic sheet. It runs parallel to the main axis of the rack. It is a by-product of the folding of the elastic sheet to form the flange 32 and is also used as means of preventing the releasing plates from moving relative to the elastic sheet. No movement of parts occurs along the axis of the channel. Lin's guide consists of two parallel grooves 55 on opposite sides of the barrel of the pistol. The flange on the rack does not slidably engage the grooves on the pistol, as any longitudinal movement would be restricted by the closed ends of the groove 55.

The channel of the present claimed subject matter is perpendicular to the main axis of the flashlight. As evident from the drawing figures, the channel is in the shape of a dovetail. The members which form the clamp move in and out of such channel. These members feature their own V-shaped channel, which slidably engages the rail guide on the weapon. These channels are open ended to allow movement along their length.

Regarding claim 3, the releasing plates 35 of Lin are used as levers to exert pressure upon the press plates, allowing them to be opened or closed through elastic deformation, not extended or retracted. The locking means of Lin consist of a flange 32 that is the same length as the

closed end groove 55, which serves as a guide on the pistol. They only prevent movement along the main axis of the barrel. Movement away from the barrel, either in a horizontal or vertical plane is limited only by the pressure exerted by press plates, which hold the rack unto the pistol.

In the present claimed subject matter, the locking means allow the lateral members to be locked in a retracted or extended position. The locking means allow restriction of movement along the axis of the guide, by engaging with notches in the rail. Prevention of vertical and horizontal movement is unnecessary, because of the use of rigid, as opposed to elastic, materials.

Regarding claim 6, the slots of Lin are elongated grooves 55, located on the pistol, which serve as guides, for mounting the rack. There are two of these grooves. They are parallel to the barrel and to one another. There cannot be more than two and both must be engaged by the corresponding flanges at once. These slots have closed ends.

In the present claimed subject matter, the cross slots are perpendicular to the guide and to the barrel. There can be one or a multitude of them, along the length of the guide. These cross slots are open ended. Only one such cross slot is engaged at once for locking the lighting device in place. This allows a multitude of positions for mounting the flashlight along the length of the barrel. Lin only allows one position.

Regarding claim 9, Lin allows the mounting of a cylindrical flashlight onto a pistol. However, once the fixing rack is attached to the flashlight, it loses its cylindrical shape. In contrast, with the present claimed subject matter the fixing means is an integral part of the light assembly, and fully retractable into the light assembly. In the retracted position, the cylindrical shape of the flashlight is preserved.

Regarding claim 12, Lin does not disclose any sliding motion to engage or disengage the fixing rack. The subject matter of claim 12 discloses retraction of the lateral members into the

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body of the light assembly by unlocking the latches, and locking them again. Lin does not teach or suggest retraction.

Claims 8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin in view of Matthews et al. (U.S. Pat. App. Pub. No. 2005/0128741, hereinafter “Matthews”). Applicant respectfully traverses.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection of claims 1-7, 9, 11 and 12 under 35 U.S.C. § 102(b) predicated upon Lin. The secondary reference to Matthews does not cure the argued deficiencies of Lin. Thus, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite realistic motivation has been established, the claimed invention will not result.

*Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Accordingly, the rejection is not legally viable and should be withdrawn.

It is believed that pending claims 1-12 are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner’s amendment, the Examiner is invited to call Applicant’s representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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